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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,937	01/24/2000	Koji Nakagiri	862.C1801	6485
5514	7590	10/21/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			BASHORE, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/489,937	NAKAGIRI ET AL.
Examiner	Art Unit	
William L. Bashore	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 24 August 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-37 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-37 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is responsive to communications: RCE filed 8/24/2004, to the original application filed 1/24/2000, with priority filing date of 1/28/1999.
2. Claims 1-37 are pending. Claims 1, 8, 15, 22, 29, 30, 31, 36, 37 are independent claims.

*Continued Examination Under 37 CFR 1.114*

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/24/2004 has been entered.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (hereinafter Schmid), U.S. Patent No. 5,659,164 issued August 1997, in view of Ogura (hereinafter Ogura), U.S. Patent No. 5,019,916 issued May 1991.

**In regard to independent claim 1**, Schmid teaches an electronic facsimile method comprising scanning a document, and electronically transmitting said document along with page specific information, said document and page information temporarily (inherently) stored in memory in an intermediate format (i.e. digital data stored in RAM memory) prior to, and during transmission of information (Schmid Abstract, column 2 lines 4-23, 27-33, 40-45, 57-61, column 4 lines 57-67; compare with claim 1 “*An information processing system....said system comprising:*”, and “*temporary storing means for temporarily storing, on a storage medium, output image data composed of a plurality of pages as well as output configuring information;*”).

Schmid teaches storing page size information on a cover page of a document, said information used for ascertaining final page size (Schmid column 4 lines 57-67, Figure 4; compare with claim 1 “*acquisition means for acquiring output size of a prescribed page....by said temporary storing means;*”).

Schmid does not specifically teach changing the size of each page based upon the output size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station’s paper size. If said receiving station’s paper size differs from the fax size, then the transmitting station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station’s paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, especially lines 5-9; compare with claim 1 “*changing means for controlling the size of each page of the output image data based upon the output size acquired by said acquisition means such that all the pages coincide in size with the output size of the prescribed page.*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura’s image resizing information to Schmid’s cover page size information, providing Schmid the benefit of destination page size information, in order to change page size (originally declared by Schmid’s cover sheet data) to fit said data, as well as fitting a variety of paper sizes within various facsimile machine brands.

Schmid teaches transferring of processed image pages (processed with Ogura’s image changing information embedded onto Schmid’s cover page) to a receiving apparatus. Schmid also teaches network address/destination routing ID (Schmid Abstract, Figure 1, column 4 lines 22-28; compare with claim 1 “*transmitting means for... by said changing means.*”).

**In regard to dependent claim 2**, Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67).

**In regard to dependent claim 3**, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

**In regard to dependent claim 4**, Schmid does not specifically teach changing the size of each page based upon the output size as specified by the cover sheet data, so as to be identical with ouput paper size. However, Ogura teaches electronic facsimile transmission whereby a transmitting station is notified of a receiving station's paper size. If said receiving station's paper size differs from the fax size, then the receiving station enlarges/reduces the fax size accordingly prior to transmission, so as to fit the receiving station's paper size (Ogura Abstract, column 10 lines 65-68 to column 11 lines 1-30, Figure 1, 4) It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Ogura to Schmid, providing Schmid the benefit of destination page size information, in order to temporarily modify Schmid's cover sheet page size content information, so as to fit a variety of paper sizes within various facsimile machine brands.

**In regard to dependent claims 5, 6,** as presented in the rejection of claim 1, above, Schmid (in view of Ogura) teaches enlarging/reducing output page sizes, based upon analysis of Schmid's cover sheet information and Ogura's applied teaching of transmitted paper size information. Since a cover sheet is typically part of a transmitted fax document, and since page size modifications apply to a faxed document, said cover sheet is also changed accordingly (see also Schmid column 4 lines 57-67) (compare with claims 5, 6).

**In regard to dependent claim 7,** Schmid teaches a fax transmission (Schmid column 2 lines 27-34, especially lines 40-44).

**In regard to claims 8-14,** claims 8-14 reflect the apparatus comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

**In regard to claims 15-21,** claims 15-21 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

**In regard to claims 22-28,** claims 22-28 reflect the computer executable methods comprising computer executable instructions used for implementing the system as claimed in claims 1-7, respectively, and are rejected along the same rationale.

**In regard to independent claim 29,** claim 29 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

**In regard to independent claim 30**, claim 30 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and is rejected along the same rationale.

**In regard to independent claim 31**, claim 31 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 31 “*to attach cover page information*”).

**In regard to dependent claim 32**, claim 32 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 7, and is rejected along the same rationale (see also Schmid Figure 1, 2A – scanned and OCR’d images of page documents).

**In regard to dependent claim 33**, claim 33 reflects the apparatus comprising computer executable instructions used for implementing the system as claimed in claim 2, and is rejected along the same rationale.

**In regard to dependent claims 34, 35**, Schmid does not specifically disclose template information associated with cover page information, as claimed. However, Schmid teaches an “MRI” comprising a set display of page information, which provides the claimed equivalent of an information template, the size of said cover page (with attached MRI) to be adjusted (scaled) as needed (Schmid Figure 1, 4), providing Schmid the benefit of a standard presentation of information for defining fax documents.

**In regard to independent claim 36**, claim 36 reflects the computer executable method comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 36 “*generating cover page information*”).

**In regard to independent claim 37**, claim 37 reflects the computer program product comprising computer executable instructions used for implementing the system as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Schmid teaches page size information embedded on a cover page (a leading page of a fax document (Schmid column 4 lines 57-67; compare with claim 37 “*generating cover page information*”).

#### *Response to Arguments*

6. Applicant's arguments filed 8/24/2004 have been fully and carefully considered but they are not persuasive.

Applicant's arguments are substantially directed to amended subject matter. Applicant argues that the Ogura changes image/paper size at a receiving end, rather then at the transmitting end. It is respectfully noted that Ogura does teach at column 11 lines 5-9 “If the size of the document to be transmitted is different from the size available at the destination, i.e. receivable size, the document is transmitted *after* being changed in magnification.” (italics added). Ogura teaches performing changes in image size prior to transmission. Although this was cited in the previous rejection, confusion may have resulted because the examiner did say that the “receiving” station enlarges/reduces the fax size accordingly prior to transmission. This has been corrected in the current rejection.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*William L. Bashore*  
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October 17, 2004